

### **CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

### **ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

## **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 17 has been amended to incorporate without prejudice the substance of claim 31.

Claim 31 has been canceled, now being redundant.

The dependencies of claims 32 and 33 have been changed from “31” to “17” in view of the change to claim 17 and the cancellation of claim 31.

Claims 53-56 have been amended to specify “non-human” at points.

Applicants do not believe that any of these changes introduce new matter. An early notice to that effect is earnestly solicited.

Claims 53-56 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. In response, as noted above, Applicants have specified “non-human” at certain points in each of the rejected claims.

Claims 31 and 53-56 were rejected under 35 USC § 112, first paragraph, as failing to satisfy the written description requirement.

With respect to claim 31, Applicants point out that the substance of this claim has been brought into main claim 17 and, accordingly, claim 31 has been canceled. However, Applicants further point out that support for the feature “heterologous relative to the Rosa26 locus” can be found in the original specification at page 8, lines 1-2. There is *ipsis verbis* support for the language in the original specification and, thus, clearly no new matter.

With respect to claims 53-55, Applicants point out that original claim 16, consistent with the specification at the top of page 5, under point (9), provided for the:

“Use of the eukaryotic cell of claim 11, the transgenic multi-cell

organism of claim 15, or the transgenic non-human mammal of claim 15 for gene function studies, drug development, as disease model animals, etc.”

Thus, there is support in the original specification for use of “a biological entity selected from a eukaryotic cell, a transgenic multi-cell non-human organism, or a transgenic non-human mammal obtainable utilizing the method of claim 17” for these purposes.

Claim 53 is directed to the use of such biological entity for studying gene functions.

Claim 54 is directed to the use of such biological entity for drug development, i.e., developing a drug.

Claim 55 is directed to the use of such biological entity in an animal model.

The remainder of each of these claims is simply a recitation of the necessary steps that would be readily apparent to anyone of ordinary skill in the art for performing such use. A specification need not teach well known necessary steps for carrying out a use specifically identified in the specification.

With respect to claim 56, the structure recited is supported, for example, by the paragraph bridging pages 9-10 of the specification.

Claims 17-19, 24, 25, 28-41, 43-46, 48 and 53-55 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have amended the claims where appropriate above in a manner which Applicants believe overcomes many of the Examiner’s concerns. Those concerns of the Examiner’s that may remain are discussed below. Applicants believe in any case that the claims are definite and, therefore, respectfully request that the Examiner reconsider and withdraw this rejection.

In accordance with the Examiner’s suggestion, Applicants have limited to “non-human mammalian cells” where appropriate.

With respect to claim 18, and the Examiner’s point at the bottom of page 4 of the final

rejection, Applicants have specified “Rosa26 gene.”

With respect to the Examiner’s concerns regarding claims 19, 28 and 30, as set forth on page 5 of the final rejection, Applicants believe the Examiner’s position is in error. The question is whether persons skill in the art understand what is intended. Applicants are able to utilize terminology that is well known in the art without the specification providing a definition for such. Applicants have explained to the Examiner that the terminology was well known in the art. The Examiner does not dispute this, but, instead, continues to insist that the specification does not provide a definition. There is no requirement in the patent law that the specification must provide definitions of terms that are well known in the art. Accordingly, Applicants request that the Examiner withdraw this concern or, if it is maintained, that the Examiner provide some legal support for this position that definiteness requires that the specification define terms that are already well known in the art.

With respect to claim 31, Applicants point out that the substance of this claim has been brought into main claim 17 and, accordingly, claim 31 has been canceled. However, Applicants further point out that support for the feature “heterologous relative to the Rosa26 locus” can be found in the original specification at page 8, lines 1-2. There is *ipsis verbis* support for the language in the original specification.

With respect to the objection to claim 32 on page 6 of the final rejection, Applicants have the same response as set forth above with respect to claims 19, 28 and 30: The specification need not provide definitions for well known terms and abbreviations. The question of indefiniteness boils down to what persons skilled in the art would understand. If they understand what a term or abbreviation means, then there is no indefiniteness and it does not matter that the specification does not provide the already well known definitions.

Claim 34 has been amended to delete “additional.”

With respect to claim 35, the Examiner has the phrase quoted incorrectly. The actual quote uses the conjunction “or,” not “and.” Consequently, there is a targeting vector or recombination vector in both claims 18 and 19 and, thus, proper dependency.

Claims 38-41 have been amended consistent with the Examiner’s suggestions.

With respect to claim 45, please see the arguments above: The specification need not define well known markers in order for the claims to be definite.

With respect to claim 46, Applicants have no idea why the Examiner imagines there are three steps. As for the Examiner’s query about the differences between “isolating the transgenic non-human mammalian cells” and “isolating the transgenic non-human mammalian cells having a *modified* functional DNA sequence,” the former has the functional DNA sequence in claim 17, whereas the latter has such a functional DNA sequence that has been subjected to some modification so that it is a modified functional DNA sequence. Thus, step (b) expressly requires “modifying the functional DNA sequence.” This results in a change or modification of the DNA sequence, and, thus, also a difference from the functional DNA sequence as originally provided.

With respect to claim 48, the further limitation from process claim 17 is that claim 48 is a product claim-by-process claim. Reciting claim 17 constitutes a limitation of the manner in which the product of claim 48 can be obtained.

With respect to claims 53-55, antecedent basis for “the gene of interest” can be found in claim 17, which recites “a gene of interest.”

With respect to claims 54 and 55, the result of the process has been moved into the preamble.

With respect to claim 55, even the cell containing the gene of interest can be used to evaluate the effect of a candidate drug on that gene.

With respect to claim 56, examples of mutually incompatible RSSs is given in the

specification. Also, claim 56 has been amended to recite the structure of the recombination vector. Further, this amendment limits the environment of the functional DNA sequence in (b) to the recited recombination vector.

Regarding the Examiner's point at the top of page 10 of the final rejection, claim 56 specifies in (c) that what is introduced is a "recombinase that catalyzes recombination between the RRSs of the acceptor DNA and donor DNA." The Examiner has not explained why this introduction could not occur before the donor DNA is itself introduced. In any case, Applicants respectfully submit that the language is clear and unambiguous and, therefore, there is no indefiniteness.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 17-25, 28-32, 34-38, 43-46, 48 and 53-56 were rejected under 35 USC § 102(b) as being anticipated by Soriano, WO 99/53017. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Soriano utilizes an endogenous Rosa26 promoter or a fragment thereof. In contrast, the instant claims require that the promoter is heterologous relative to Rosa26. Consequently, Soriano does not anticipate the instant claims.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance.

However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/

Kurt G. Briscoe

Attorney for Applicant(s)

Reg. No. 33,141

875 Third Avenue - 18<sup>th</sup> Floor

New York, New York 10022

Phone: (212) 808-0700

Fax: (212) 808-0844